

Ihara does not teach or suggest a navigation apparatus including a "display control unit for determining whether or not a user selects one of the main points and displaying a real image showing a surrounding of a selected main point on the display screen on a basis of position information of the selected main point and real image data corresponding to position coordinates, when the second display control unit determines that the user selects one of the main points, wherein the real image includes at least one of an aerial photograph and a satellite photograph," as recited in independent claim 1, and similarly recited in independent claim 2.

Ihara also does not teach or suggest a navigation apparatus including "a first selection unit for selecting a point, a real image of which is to be displayed on the display screen, from among main points on a route to the destination on a basis of a movement state of the vehicle, wherein the real image includes at least one of an aerial photograph and a satellite photograph," as recited in independent claim 3.

A. The Asserted Combination of Ihara and Shimizu is Improper

1. The Required Motivation is Lacking

MPEP §2143.01 states the following:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

The statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some suggestive reason to combine the teachings of the references.

Ihara teaches a navigation device, in Fig. 1, including a display control unit 34, a route-setting control unit 37, and an object control unit 39. The object control unit 39

includes a command detection unit 40 that determines whether or not the user has selected a region corresponding to control button B, and an object information control unit 43. See Fig. 2 and paragraph [0053]. The control units 39, 43 process and control the navigation device to create and edit marks or objects O each representing a point of interest on a map, and creates an associated object information I for the mark O. See paragraph [0057].

The associated object information I may include guide information such as hours of a business, days on which an establishment is closed, address information and telephone number. See paragraph [0017]. The associated object information I may also include a photograph related to a point on a map to which the mark O is attached. See Figs. 3A-5B, and paragraphs [0017] and [0057]. Therefore, Ihara teaches the creation of "main points" on a route displayed on the map image. See Abstract, and paragraph [0017].

Although Ihara also discloses that it is possible for the image on the display means to be an image other than a map, Ihara merely teaches that editing and marking a position on a route may be performed on different types of images. See paragraph [0022]. For example, Ihara teaches that route information may be displayed on a map image or an image other than a map. See paragraph [0022]. Therefore, Ihara does not teach or suggest that the object information I associated with the mark O may itself be an aerial or satellite photograph information.

The Office Action admits that Ihara merely discloses that photographs may be displayed corresponding to a mark on a route. See page 3 of March 23, 2005 Office Action. However, the Office Action asserts that Shimizu remedies the deficiencies of Ihara. Specifically, the Office Action asserts that Shimizu teaches an aerial or satellite photograph encompassing a point along a displayed navigation route. See Fig. 6A, and col. 6, lines 21-40. The Office Action asserts that it would have been obvious to one of ordinary skill in the art to apply the aerial or satellite photograph of Shimizu to the navigation apparatus of Ihara

because use of aerial or satellite photographs for the purposes of navigation are well-known in the art. Applicant respectfully disagrees and submits that such a statement of motivation is contrary to MPEP §2143.01 quoted above.

Shimizu teaches that actual conditions around a current position of a vehicle cannot be easily recognized to fulfill the basic functions of the navigation system if there are narrow roads that are not shown in a map image, or if the vehicle is located in a place where large buildings disturb a view of the user. See col. 1, lines 39-45. Therefore, Shimizu teaches a navigation system that will allow the user to easily recognize conditions around a current position of the vehicle. See col. 1, lines 56-58.

Shimizu teaches that the navigation system may include a display controlling device coupled to a position measuring device and a storing device. Shimizu also teaches a displaying device that displays a mark based on a measured current position of a movable body and a stored aerial photograph data. See col. 1, line 59 - col. 2, line 2. Conditions around the current position of the movable body may include a group of buildings, agriculture fields, orchid fields, etc., and may be displayed in the aerial photograph image in addition to the mark indicating the current position on the display device. See col. 2, lines 3-7. As a result, Shimizu teaches that a current position of the movable body can be easily recognized by comparing conditions shown on the aerial photograph image with actual objects around the movable body. See col. 2, lines 7-12. Therefore, Shimizu merely teaches displaying a mark, indicating a current position located on an aerial photograph image, based on a current position of the movable body. The indicated current position is not a user-selected main point located on a route.

Shimizu also teaches that a display 17 may be selectively switched to display a current position of a movable body on an aerial photograph image or a map image based on the desires of a user. See Fig. 6A-6B and col. 6, lines 21-50. Therefore, Shimizu teaches that the

background image on which a route or current position of a movable body may be displayed or may be an aerial photograph image or a map image. Therefore, like Ihara, Shimizu merely teaches changing a background on which route information is to be displayed.

In the navigation apparatus of claims 1-3, main points on a route are associated with real image data, e.g., aerial photograph or satellite photograph. One of the main points may be selected and the real image data for the selected main point is displayed. See page 16, line 12-20 of the specification. As a result, the real images, e.g., aerial images, of the surroundings of each main point may be displayed at any time when the main point is selected, e.g., before the vehicle arrives at a destination or passes-through the main point. See page 16, line 2 - page 17, line 2. See also page 20, lines 2-23. Neither Shimizu nor Ihara teaches or suggests such advantages.

Because neither Ihara nor Shimizu teach or suggest displaying an aerial photograph image based on and associated with a selected main point provided on a route, the combination of Shimizu and Ihara to allegedly achieve the features recited in claims 1-3 as suggested by the Office Action constitutes impermissible hindsight reasoning. Therefore, one of ordinary skill in the art would not have been motivated to combine the references as asserted by the Office Action.

2. The Modification Alleged by the Final Office Action Would Not Result From Any Permissible Combination of Ihara and Shimizu

A permissible combination of the teachings of Ihara and Shimizu would not result in the modification alleged by the Office Action. As discussed above, both Ihara and Shimizu teach that route information and marks may be displayed on various background images. Therefore, a combination of teachings of Ihara and Shimizu would arguably result in changing a background image between a map image and an aerial photograph image. Because Shimizu does not teach a user selecting a main points, e.g., marks set by the user,

with associated aerial photograph images, Shimizu cannot supply the features of claim 9 admittedly missing from Ihara. Using an aerial photograph image as taught by Shimizu in the navigation device of Ihara would not achieve the features recited in claims 1-3.

Because no motivation exists in either Ihara or Shimizu to combine the teachings of the references, and because neither Shimizu nor Ihara teach or suggest a navigation apparatus including selecting a main point to display an aerial image associated with the main point provided on a route, Shimizu and Ihara do not teach or suggest, alone or in combination, the navigation apparatus of claims 1-3.

B. Walker and Berstis Do Not Remedy the Deficiencies of Ihara and Shimizu

The Office Action asserts that Walker and Berstis remedy the deficiencies of Ihara and Shimizu. However, the Office Action admits that one would not have found it obvious to modify Walker and Berstis with the teachings of Shimizu. See page 4, no. 6 of the March 23, 2005 Office Action. MPEP §2141.03 indicates that prior art references must be considered in their entirety, including disclosures that teach away from the claims. Because the Office Action admits that Berstis and Walker would not have suggested the use of aerial or satellite photographs, Walker and Berstis teach away from a combination with the teachings of Shimizu. Therefore, it would not have been obvious for one of ordinary skill in the art to modify the teachings of Ihara and Shimizu in view of Walker and Berstis.

II. Conclusion

For at least the reasons discussed above, claims 1-3 would not have rendered obvious by Ihara, Shimizu, Walker and/or Berstis. Claims 4-14 variously depend from claims 1-3, and thus also would not have been rendered obvious by Ihara, Shimizu, Walker and/or Berstis for at least the reasons set forth above, as well as for the additional features they

recite. Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-14 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Holly N. Moore
Registration No. 50,212

JAO:HNM/brp

Date: June 23, 2005

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--